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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,193	04/06/2004	Bruce B. Bealke	CPSH-004/00US 307167-2003	7414
23419 7590 11/25/2009 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001				
EXAMINER				
LONG, PONYA M				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
11/25/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,193

Applicant(s)

BEALKE ET AL.

Examiner

FONYA LONG

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This communication is a Non-Final Office Action rejection on the merits in response to communication received on July 22, 2009. Claims 1 and 9 have been amended. Claim 8 is cancelled. Claims 1-26 are currently pending and have been addressed below.

Response to Amendment

1. Applicant's amendments are sufficient to overcome the 112 1st rejections and the 112 2nd rejection for Claim 26 set forth in the previous office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 5, the claim provides the limitation of stating that the standard of care was met and stating that the standard of care was not met. It is unclear how a standard can be met and not be met at the same time. The written description fails to provide an explanation on how the standard of care can be met and not be met at the same time.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-7 and 9-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

As per Claims 1-7 and 9-26, the claims recite the use of a first computer by a third party to redact information from documents (i.e. edit documents) and the use of a second computer by an expert to prepare an objective evaluation. Examiner asserts the use of a computer by a user to perform data manipulation such as editing or creating documents is considered an insignificant extra-solution activity since the party is the actual person performing the step with the aid or use of a common computer.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 9-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646).

As per Claim 1, Walker et al. discloses a computer-facilitated double blind evaluation method (Col. 20, Lines 50-65, discloses a method of providing anonymity when requesting and providing an expert opinion), comprising the steps of:

retention by an entity having a direct or indirect interest in the claim of a neutral third party to obtain an independent evaluation of the claim (Col. 7, Lines 6-29, discloses retention of a neutral third party via a person accessing an online Exchange (i.e. neutral third party) to obtain an independent expert opinion);

acquisition by the neutral third party of facts relating to the claim which are sufficient to permit an independent objective evaluation of the claim (Col. 7, Lines 6-29, discloses the online Exchange acquiring a full description of the job to be performed and any other information necessary to respond to the expert request submitted by the user to be given to the expert for evaluation);

retention by the neutral third party of a qualified independent expert to perform the claim evaluation (Col. 21, Lines 27-36, discloses a retention of an expert by the

online Exchange submitting a request to an expert and the expert accepting the request by submitting an acceptance message to the central controller);

submission by the neutral third party of the sufficient facts after redaction to the expert in order to permit the expert to make an independent objective evaluation of the claim (Col. 21, Lines 12-26, discloses the online Exchange submitting an expert request to the qualifying expert where (Col. 7, Lines 6-29) the expert request includes a full description of the job to be performed and any other information necessary to respond to the expert request);

preparation by the expert, using a second computer, of a written independent objective evaluation of the claim (Col. 21, Lines 37-61, discloses an expert preparing a written independent evaluation via developing an expert answer in response to the request);

providing, as an output from the second computer, the written independent objective evaluation of the claim (Col. 21, Lines 38-61, via the expert transmitting the expert answer to the central controller);

submission of the written independent objective evaluation by the expert to the neutral third party (Col. 21, Lines 37-61, discloses the expert submitting an expert answer to the online Exchange); and

providing the redacted evaluation to the entity retaining the third party (Col. 21, Lines 37-61, discloses submitting the expert answer to the entity retaining the third party (i.e. online Exchange)).

However, Walker et al. fails to explicitly disclose redaction of information from a document.

Rackman discloses an access control system for litigation document production with the concept of redaction by the third party of information from a document (Col. 1, Line 60-Col. 2, Line 21, discloses redacting privileged information from a document).

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus to facilitate and support expert-based commerce of Walker et al. to include redaction of information from a document as taught by Rackman in order to maintain anonymity and security by redacting privileged and identifying information from documents exchanged.

As per Claim 9, Walker et al. discloses a computer facilitated method for evaluating a malpractice claim, comprising:

receiving, at a neutral third party, from a retaining party, a set of facts relating to the claim, said set of facts including facts sufficient to permit an objective evaluation of the claim (Col. 7, Lines 6-29, discloses the online Exchange acquiring a full description of the job to be performed and any other information necessary to respond to the expert request submitted by the user to be given to the expert for evaluation);

selecting an independent, neutral medically trained expert to evaluate the claim (Col. 21, Lines 27-36, discloses the selection of an expert by the online Exchange submitting a request to an expert and the expert accepting the request by submitting an acceptance message to the central controller);

providing, from the neutral third party, the set of redacted facts to the expert for evaluation (Col. 21, Lines 12-26, discloses the online Exchange submitting an expert request to the qualifying expert where (Col. 7, Lines 6-29) the expert request includes a full description of the job to be performed and any other information necessary to respond to the expert request); and

receiving, at the neutral third party, from the expert, an objective evaluation of the claim based on said set of redacted facts (Col. 21, Lines 37-61, discloses the expert submitting an expert answer to the online Exchange); and

providing said redacted objective evaluation to the retaining party (Col. 21, Lines 37-61, discloses submitting the expert answer to the entity retaining the third party (i.e. online Exchange)).

However, Walker et al. fails to explicitly disclose redaction of information from a document.

Rackman discloses an access control system for litigation document production with the concept of redaction by the third party of information from a document (Col. 1, Line 60-Col. 2, Line 21, discloses redacting privileged information from a document).

Therefore, from the teaching of Rackman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus to facilitate and support expert-based commerce of Walker et al. to include redaction of information from a document as taught by Rackman in order to maintain anonymity and security by redacting privileged and identifying information from documents exchanged.

As per Claims 10 and 11, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the retaining party as a claimant or a claimant's representative; or an insurance company or an insurance company's representative.

Examiner asserts the identity of the retaining party is considered non-functional descriptive information. The fact that the retaining party is a claimant, a claimant's representative, an insurance company, or an insurance company's representative does not change the function of the claimed invention. Examiner asserts that the Walker et al. and Rackman combination is fully capable of utilizing a retaining party as a claimant, a claimant's representative, an insurance company, or an insurance company's representative.

As per Claims 12 and 13, Walker et al. discloses an expert being selected at least in part based on having a medical board certification and a professional registration in a medical specialty related to one or more treatments or conditions identified in the claim (Col. 20, Lines 50-65, discloses providing an expert opinion in regards to medical malpractice. Col. 25, Line 35-Col. 26, Line 14, discloses an expert being selected based on the expert qualifications).

Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to expert qualifications be medical board certification and professional registration. It is well known in the legal profession and field to qualify a witness and an expert witness based on certifications and professional registrations when wanted to enter expert opinions into evidence.

As per Claim 17, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the objective evaluation including an objective monetary valuation of the claim.

Examiner asserts that the objective evaluation including an objective monetary valuation of the claim is considered non-functional descriptive material. The information contained in the objective valuation provided to the retaining party does not change the function of the claimed invention. Examiner asserts that the Walker et al. and Rackman combination is fully capable of utilizing an objective evaluation having an objective monetary valuation of the claim.

Examiner Notes: The type of data contained in a document such as an objective evaluation stated in claim 17 fails to change the method step of creating a document. Examiner asserts the method step of creating a document (i.e. typing information) would be performed the same regardless of the type of information contained in the document.

8. Claims 2, 3, and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claims 1 and 9 above, and further in view of *Medical Experts & Establish Standards of Care in Malpractice Cases* (November 21, 2000).

As per Claim 2, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 1, above. However, the combination fails to explicitly disclose acquiring a plurality of the following: facts and documents that relate to the claim; background information about the party asserting the claim; background

information about the party against whom the claim is asserted; and facts about the party's peer group in the same geographic area.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses that an expert witness must assert familiarity with the treatment of patients with the plaintiff's complaint by physicians similarly situated to the defendant and that an expert witness may offer an opinion as to whether the defendant (i.e. physician) was qualified to treat the plaintiff's condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain facts and documents that relate to the claim and background information about the party asserting the claim (i.e. patient) and about the party against whom the claim is asserted (i.e. physician) in order for the expert to develop a conclusion as to whether based on the plaintiff's condition and the defendant's actions the defendant did not meet the standard of care and as to whether the defendant was qualified to treat the plaintiff.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include acquiring a plurality of the following: facts and documents that relate to the claim; background information about the party asserting the claim; background information about the party against whom the claim is asserted; and facts about the party's peer group in the same geographic area as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide the expert with information that would enable the expert to provide an informed expert opinion.

As per Claim 3, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 2, above. However, the combination fails to explicitly disclose a plurality of the following types of information: resumes; at least one curriculum vitae; educational history; employment history; and professional training.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses an expert witness offering an opinion as to whether the defendant (i.e. physician) was qualified to treat the plaintiff's condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain information about the defendant such as training, employment history, and education in order for the expert to determine based on the information provided whether the defendant was qualified to treat the plaintiff's condition.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include disclose a plurality of the following types of information: resumes; at least one curriculum vitae; educational history; employment history; and professional training as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide the expert with information that would enable the expert to provide an informed expert opinion.

As per Claims 18 and 20, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination

fails to explicitly disclose the objective evaluation including a description of relevant standards of care.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses an expert providing a description of relevant standards of care for one or more medical conditions or treatments associated with the claim (Page 1, discloses the expert establishing a standard for medical care and giving an opinion on whether the defendant's conduct met this standard), wherein said relevant standards of care include at least one of a local or regional standard of care and one of a national standard of care (Page 2, discloses a national standard of care).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the Walker et al. and Rackman combination to include the objective evaluation including a description of relevant standards of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in to provide an informed expert opinion.

Examiner asserts the that the standard of care including a gold standard of care is considered non-functional descriptive material. The standard of care including a gold standard of care does not change the function of providing an objective evaluation. Examiner asserts the Walker et al., Rackman, and *Medical Experts & Establish Standards of Care in Malpractice Cases* is fully capable of utilizing a gold standard of care.

As per Claims 19 and 21, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose citations from medical literature related to each of said relevant standards of care.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses citations from medical literature related to each of said relevant standards of care (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

As per Claim 22, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to disclose a description of one or more standards of care; and one or more arguments why the treatment rendered did or did not meet the one or more applicable standard of care.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses a description of one or more standards of care applicable to a treatment associated with the claim; one or more arguments why the treatment rendered met the one or more

applicable standards of care; and one or more arguments why the treatment rendered did not meet the one or more applicable standards of care (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include a description of one or more standards of care; and one or more arguments why the treatment rendered did or did not meet the one or more applicable standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide an informed expert opinion.

As per Claim 23, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 22, above. However, the combination fails to explicitly disclose providing for each of said arguments, a citation to the medical literature.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses citations from medical literature related to each of said relevant standards of care (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

As per Claim 24, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose the objective evaluation including a description of a suggested court treatment.

Examiner asserts the contents contained in the objective evaluation is considered non-functional descriptive material. The objective evaluation having a description of a suggested course of treatment does not change the function of the claimed invention. Examiner asserts the Walker et al. and Rackman combination is fully capable of utilizing an objective evaluation including a description of a suggested course of treatment.

As per Claim 25, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to explicitly disclose selecting one or more standards of care and providing an objective evaluation based on the standard of care.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses said objective evaluation is prepared by said expert by:

selecting one or more standards of care applicable to one or more medical treatments associated with the claim (Page 1, discloses the expert establishing a

standard of care and giving an opinion on whether the defendant's conduct met this standard of care);

assuming, for each board-certified physician who rendered care to the claimant, that the physician's retention of such certification depends on whether the treatments rendered by the physician met the appropriate standards of care for a board-certified physician treating said medical conditions; and

including, in said objective evaluation:

a description of the one or more medical treatments rendered by the board-certified physician;

the selected standard or standards of care applicable to said one or more medical treatments;

an opinion regarding whether each of said one or more medical treatments rendered met the selected standard or standards of care; and

an explanation for each opinion (Page 1, discloses the expert providing a standard of care and an opinion on whether the defendant's conduct met this standard, which is supported by uncontroverted scholarly literature (i.e. explanation of opinion).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include selecting one or more standards of care and providing an objective evaluation based on the standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide an informed opinion.

As per Claim 26, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 25, above. However, the combination fails to disclose one or more citations of medical literature.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses citations of medical literature supporting each opinion (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

9. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claim 1 above, and further in view of *Liebig-Grigsby v. United States of America* (March 12, 2003) and *Medical Experts & Establish Standards of Care in Malpractice Cases* (November 21, 2000).

As per Claim 4, the Walker et al. and Rackman disclose the claimed invention as applied to Claim 1, above.

Liebig-Grigsby v. United States of America discloses an expert witness providing an expert opinion with the concept of wherein preparation by the expert of a written independent objective evaluation of the claim comprises:

stating medical cause of claimant's condition (Page 4, discloses the expert Dr. Wilberger stating the medical cause of the Plaintiff's condition as cervical myelopathy);

stating whether there was any action/inaction by the claimant which can be attributed to or cited as the cause of current condition, listing by symptoms and/or cause (Pages 9 and 10, discloses the expert stating that due to the failure to refer the Plaintiff to a neurosurgeon and due to the neurosurgeon not ordering an MRI, the physicians deprived the Plaintiff of the opportunity for an intervention that could have stabilized or perhaps improved the Plaintiff's condition. As a result, the Plaintiff's condition deteriorated to the point where the Plaintiff is currently confined to a wheelchair); and

stating the identity of each provider providing treatment to the claimant (Pages 9 and 10, discloses the expert Dr. Wilberger, identifying Dr. Garmon, and Dr. Orfei as the physicians who provided treatment to the Plaintiff) and, for each provider,

stating each symptom/cause treated by that provider and the treatment rendered to claimant (Pages 4-9, via the findings of fact disclosing the expert Dr. Wilberger stating the Plaintiff's medical conditions (i.e. symptom/cause) and (Pages 9-11) Dr. Wilberger stating the treatment (or lack of treatment) that was provided by each physician (i.e. Dr. Orfei and Dr. Garmon)).

Therefore, from the teaching of *Liebig-Grigsby v. United States of America*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al. and Rackman combination to include stating a medical cause; stating whether there was any action/inaction by the claimant; stating the identity of each provider; and stating each symptom/cause treated as taught by *Liebig-Grigsby*

v. United States of America in order to aid in providing an expert opinion for a medical malpractice claim.

However, *Liebig-Grigsby v. United States of America* fails to explicitly disclose the expert providing citations from medical literature and stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses the requirements for an expert witness with the concept of the expert providing citations from medical literature (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature); and the expert stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care, and providing citations from medical literature for all arguments (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination to include the expert providing citations from medical literature and stating at least one argument why each treatment actually rendered did or did not meet the applicable standard of care as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide

scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

As per Claim 5, the Walker et al., Rackman, and *Liebig-Grigsby v. United States of America* combination discloses the claimed invention as applied to Claim 4, above. However, the combination fails to explicitly disclose the expert stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care and providing citations from medical literature for all arguments.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses the requirements for an expert witness with the concept of the expert stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care, and providing citations from medical literature for all arguments (Page 1, via an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature). It would be obvious to one of ordinary skill in the art at the time of the invention to have an expert state when a treatment rendered met a standard of care and also state when a treatment rendered did not meet a standard of care in order to provide a clear analysis as to what was the cause of the claimants injuries and to determine what specific actions should the defendant be held accountable for as a violation of the standard of care.

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walker et al., Rackman, and

Liebig-Grigsby v. United States of America combination to include the stating at least one argument why each treatment actually rendered did and did not meet the applicable standard of care and providing citations from medical literature for all arguments as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

As per Claims 6 and 7, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claims 4 and 5, above.

Liebig-Grigsby v. United States of America discloses the expert stating the treatment that the expert would have selected to be rendered to the claimant, given the claimant's symptom and/or cause (Page 9, discloses the expert Dr. Wilberger stating the he would have rendered a second surgery to the claimant based on the conditions of the claimant).

However, *Liebig-Grigsby v. United States of America* fails to explicitly disclose the expert providing citations from medical literature.

Medical Experts & Establish Standards of Care in Malpractice Cases discloses the requirements for an expert witness with the concept of the expert providing citations from medical literature (Page 1, via an expert witness opinion must be supported by uncontroverted scholarly literature).

Therefore, from the teaching of *Medical Experts & Establish Standards of Care in Malpractice Cases*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker et al., Rackman, and *Liebig-Grigsby*

v. United States of America combination to include the expert providing citations from medical literature as taught by *Medical Experts & Establish Standards of Care in Malpractice Cases* in order to provide scientific support to the expert's opinion in determining whether a defendant violated the standard of care.

10. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claim 9 above, and further in view of Fromm (2001).

As per Claims 14 and 15, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to disclose the concept of precluding an expert from obtaining any information regarding the outcome of the claim.

Fromm discloses confidentiality clauses in settlement agreements with the concept of parties being prohibited from disclosing settlement information to third parties (i.e. experts) which results in third parties being unable to obtain settlement information (i.e. information regarding the outcome of a claim) (Pages 675-677).

Therefore, from the teaching of Fromm, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker and Rackman combination to include precluding an expert from obtaining any information regarding the outcome of the claim as taught by Fromm in order to aid in protecting the reputations of the parties and prevent exposure to additional liability claims.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (5,862,223) in view of Rackman (5,903,646) as applied to claim 9 above, and further in view of Florida Statute 766.104 (2002).

As per Claim 16, the Walker et al. and Rackman combination discloses the claimed invention as applied to Claim 9, above. However, the combination fails to disclose retaining an expert prior to filing of any litigation.

Florida Statute 766.104 discloses retaining an expert prior to filing of any litigation (Page 1, a claimant or his or her counsel obtain an written expert opinion prior to filing of litigation in order to show grounds for a good faith belief that grounds exist for an action).

Therefore, from the teaching of Florida Statute 766.104, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker and Rackman combination to include retaining an expert prior to filing of any litigation as taught by Florida Statute 766.104 in order to prevent frivolous claims from being filed.

Response to Arguments

12. Applicant's arguments filed July 22, 2009 have been fully considered but they are not persuasive.

112 2nd Rejection

As per Claim 5, Applicant asserts "that in many, if not most, litigation matters, the opposing parties will assert contrary positions, with one party taking a position that the standard of care was met and another taking a position that it was not met." Examiner asserts that the claims are directed to a single party obtaining an expert opinion rather than both of the parties involved in the conflict. Examiner asserts that an expert providing a position that the standard of care was met and that the standard of care was not met in the same evaluation, would defeat the entire purpose of retaining an expert opinion since the evaluation would not provide a definite conclusion as to whether the standard of care was met or not. An evaluation by an expert of this matter would not aid a party that has obtained the expert in arguing advantageous of the retaining party's position.

101 Rejection

As per Claims 1-7 and 9-26, Applicant argues that the claims are considered statutory subject matter under 35 USC 101. Examiner respectfully disagrees. Examiner asserts the claims recite the use of a first computer by a third party to redact information from documents (i.e. edit documents) and the use of a second computer by an expert to prepare an objective evaluation. Examiner asserts the use of a computer by a user to perform data manipulation such as editing or creating documents is considered an insignificant extra-solution activity since the party is the actual person performing the step with the aid or use of a common computer.

103 Rejections

As per Claims 1 and 9, Applicant argues that the Walker and Rackman combination fails to disclose "redaction by a neutral third party so as to prevent identification of any party involved in or having an interest in the claim by an expert retained to evaluate the claim;" and redaction by a neutral third party from a written claim evaluation provided by the expert, any information which would permit identification of the expert. Examiner respectfully disagrees. Examiner asserts Walker discloses the concept of concealing the identity of the parties involved in receiving and expert opinion via providing full anonymity to the end user and expert (Col. 9, Line 66-Col. 10, Line 26). However, Walker fails to disclose the redaction concept. Rackman discloses the redaction concept via redacting privileged information from a litigation document (Col. 1, Line 60-Col. 2, Line 21). Examiner asserts that the type of person performing the redaction holds little patentable weight in the method claims. The person involved in performing the redaction fails to affect the actual method functional step of redacting information from a document. The process of redacting information from a document would be performed the same regardless of the type of person performing the method step. Examiner also asserts that Applicant has admitted that the redaction concept is not novel via Page 19 of Remarks. Examiner asserts that it would have been obvious to modify the Walker reference to include the known technique of redaction as taught by Rackman in order to aid in providing full anonymity by remaining identification information from the documents. Examiner refers Applicant to MPEP 2141 and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396. Applicant argues that Walker

teaches away from the present invention and the Rackman reference. Examiner respectfully disagrees. Examiner asserts that Walker discloses several different embodiments, one being where end user is provided the expert's name (Col. 7, Lines 62-Col. 8, Line 15). Walker discloses another embodiment, wherein the identity of the end user and the experts are kept anonymous (Col. 9, Line 66-Col. 10, Lines 26). Applicant is mistaken in stating that Walker discloses "identifying the expert and/or facilitating direct contact between the end user and the expert" is the desired method. Walker does not recite that are being a desired method but rather simply recite it as being one of the numerous alternative methods. Examiner asserts that the Walker reference does not teach away from the concept of withholding identification information as taught in Applicant's present invention and Rackman but rather supports the concept.

As per Claims 14-16, Applicant's arguments with respect to claims 14-16 have been considered but are moot in view of the new ground(s) of rejection.

As per Claim 17, Applicant argues that the claim is not directed to non-functional descriptive material. Examiner respectfully disagrees. Examiner asserts that Claim 17 is directed to the type of information contained in a objective evaluation document. Examiner asserts the type of information contained in a document hold little patentable weight in terms of the method of creating a document. Examiner asserts the creation of the document (i.e. the typing of information) would be performed the same by a user regardless of the type of information the user is providing.

As per Claims 5 and 22, Applicant argues that the Walker, Rackman, and Medical Experts combination fails to disclose "providing one or more arguments why the treatment rendered met the one or more applicable standards of care and one or more arguments why the treatment did not meet the applicable standards of care." Examiner respectfully disagrees. Examiner asserts Medical Experts discloses (Page 1) an expert witness establishing a standard for medical care and giving an opinion on whether the defendant's conduct did or did not meet this standard and supporting his opinion by uncontroverted scholarly literature). It would be obvious to one of ordinary skill in the art at the time of the invention to have an expert state when a treatment rendered met a standard of care and also state when a treatment rendered did not meet a standard of care in order to provide a clear analysis as to what was the cause of the claimants injuries and to determine what specific actions should the defendant be held accountable for as a violation of the standard of care. Examiner also asserts that Claims 5 and 22 are directed to the type of information contained in a objective evaluation document. Examiner asserts the type of information contained in a document hold little patentable weight in terms of the method of creating a document. Examiner asserts the creation of the document (i.e. the typing of information) would be performed the same by a user regardless of the type of information the user is providing.

As per Claim 24, Applicant argues that the claim is not directed to non-functional descriptive material. Examiner respectfully disagrees. Examiner asserts that Claim 24 is directed to the type of information contained in a objective evaluation document. Examiner asserts the type of information contained in a document hold little patentable

weight in terms of the method of creating a document. Examiner asserts the creation of the document (i.e. the typing of information) would be performed the same by a user regardless of the type of information the user is providing.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Jan Mooneyham/
Supervisory Patent Examiner